

REMARKS

This Amendment, submitted in response to the Office Action dated May 26, 2005, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-99 are all the claims pending in the application.

I. Claim Objection

Claim 30 has been objected to for informalities. Claim 30 has been amended as indicated above. Consequently, Applicant requests that the objection to claim 30 be withdrawn.

II. Rejection of claims 1, 30, 31, 60, 61 and 90 under 112, first paragraph

Claims 1, 30, 31, 60, 61 and 90 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner asserts that the step of “storing said custom content object in said one or more object servers; storing attribute information concerning the custom content object in said one or more object servers; and storing information specifying the custom content object and the attribute information in the library server” is not described in the specification.

“[S]toring said custom content object in said one or more object servers” is described at, for example, page 8, lines 14-19 and page 9, lines 7-11 of the specification. See also, Fig. 3, object server 48. “[S]toring attribute information concerning the custom content object in said one or more object servers” is described at, for example, page 10, lines 10-15. “[S]toring information specifying the custom content object and the attribute information in the library server” is described at, for example, page 8, lines 20-23, page 12, lines 1-5 and page 39, lines 1-5. See also, Fig. 3, library server 44.

Therefore, Applicant submits that the claim recitations are disclosed in the specification. Consequently, the 112, first paragraph rejection of claims 1, 30, 31, 60, 61 and 90 should be withdrawn.

III. Rejection of claims 30, 60 and 90 under 112, second paragraph

Claims 30, 60 and 90 have been rejected under 37 C.F.R. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner asserts that the limitation “the selected content entities” lacks sufficient antecedent basis. Claims 30, 60 and 90 have been amended as indicated above. Consequently, the 112, second paragraph rejection of claims 30, 60 and 90 should be withdrawn.

IV. Rejection of claims 1, 6-8, 11-23, 25-28, 30-31, 36-38, 41-53, 55-58, 60-61, 66-68, 71-83, 85-88, 90-91, 94 and 97 under 103(a) as being unpatentable over McGraw in view of Santamaki

Claims 1, 6-8, 11-23, 25-28, 30-31, 36-38, 41-53, 55-58, 60-61, 66-68, 71-83, 85-88, 90-91, 94 and 97 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing; hereinafter “McGraw”]¹ in view of Santamaki et al. [USP 6,886,036 B1; hereinafter “Santamaki”].

Applicant respectfully submits the following in traversal of the rejection, assuming, only for the purposes of argument, that the McGraw reference qualifies as prior art under § 102, since the reference does not state a date of publication.

¹ The “McGraw Hill Primis Custom Publishing” reference the Examiner relies on in support of the rejection under §103 at page 4 of the Office Action appears to be the reference that states on the top of its front page “McGraw Hill Digital Solutions” and states at the bottom of that page “McGraw-Hill Primis Custom Publishing.”

Claim 1 recites “storing said custom content object in said one or more object servers; and storing attribute information concerning the custom content object in said one or more object servers.” However, the Examiner has not established where the one or more object servers are disclosed in the cited art. The Examiner asserts that the screen shot on page 9 of the McGraw Hill power point presentation with the button “view” for retrieving the content of a particular chapter *implies* the technique of storing as recited in claim 1. However, as indicated above, the Examiner has not established where an object server is disclosed, let alone that a custom content object and attribute information are stored in an object server. Moreover, the standard for determining obviousness is whether there is a teaching or suggestion in the prior art that would motivate one of ordinary skill in the art to modify or combine references and not whether the prior art “implies” the claimed recitation.

Also, the Examiner concedes that McGraw does not disclose “storing information specifying the custom content object and the attribute information in the library server,” and cites Santamaki, col. 2, lines 25-28, to cure the deficiency. The respective column and lines cited by the Examiner discloses an e-book server 30, shown in Fig. 1, that stores an electronic document selected from a central server and which is converted into an e-book format. The e-book server of Santamaki stores an electronic document selected from a central server converted into an e-book format for later downloading to a remote e-book terminal. However, Santamaki provides no teaching or suggestion of storing information specifying a custom content object and attribute information concerning the custom content object in a library server (allegedly the e-book server 30, shown in Fig. 1 of Santamaki, as cited by the Examiner) in addition to storing the custom content object and attribute information in one or more object servers as required by claim 1.

Rather, Santamaki merely discloses storing the document in an e-book format in the e-book server 30. Accordingly, even if the references were to be combined, the Examiner has not established a *prima facie* case of obviousness.

For at least the above reasons, claim 1 and its dependent claims should be deemed allowable. To the extent claims 30, 31, 60, 61 and 90 recite similar elements, they should be deemed allowable for at least the same reasons.

V. Rejection of claims 2-3, 29, 32-33, 59, 62-63, and 89 have been rejected under 103(a) as being unpatentable over McGraw in view of Mortimer

Claims 2-3, 29, 32-33, 59, 62-63, and 89 have been rejected under 103(a) as being unpatentable over McGraw in view of Mortimer et al. [USP 6,091,930]. Claims 2-3, 29, 32-33, 59, 62-63, and 89 should be deemed allowable by virtue of their dependency to claim 1, 31 and 61 for the reasons set forth above. Moreover, Mortimer does not cure the deficiencies of McGraw and Santamaki.

VI. Rejection of claims 4-5, 34-35 and 64-65 have been rejected under 103(a) as being unpatentable over McGraw in view of ksinclair.com

Claims 4-5, 34-35 and 64-65 have been rejected under 103(a) as being unpatentable over McGraw in view of ksinclair.com [Free E-books You Can Download]. Claims 4-5, 34-35 and 64-65 should be deemed allowable by virtue of their dependency to 1, 31 and 61 for the reasons set forth above. Moreover, ksinclair.com does not cure the deficiencies of McGraw and Santamaki.

VII. Rejection of claims 9-10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 under 103(a) as being unpatentable over McGraw in view of Poole

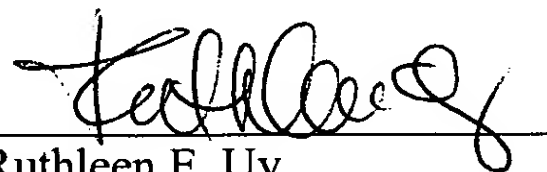
Claims 9-10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 have been rejected under 103(a) as being unpatentable over McGraw in view of Poole et al. [USP 6,006,242]. Claims 9-10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 should be deemed allowable by virtue of their dependency to claims 1, 31 and 61 for the reasons set forth above. Moreover, Poole does not cure the deficiencies of McGraw and Santamaki.

VIII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

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